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REED SMITH LLP 101 Second Street Suite 1800 SAN FRANCISCO, CA 94105			EXAMINER KOPPIKAR, VIVEK D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN R. COX and THOMAS R. QUIRK

Appeal 2009-002771
Application 10/091,860
Technology Center 3600

Decided: March 18, 2010

Before JENNIFER D. BAHR, STEFAN STAICOVICI and
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Steven R. Cox and Thomas R. Quirk (Appellants) appeal under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 1-18. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

Appellants' invention relates to a method and system for determining the risk to a human in an environment having multiple areas, where each area has a different level of risk, by detecting the presence of the human in at least one area and deriving a risk assessment based on the human's presence in the at least one area. Spec. 3, ll. 22-25; Spec. 4, ll. 29-30; and fig. 1.

Claims 1 and 10 are representative of the claimed invention and read as follows:

1. A method for measuring risk exposure to a human in an environment, wherein the environment includes multiple areas, the method comprising:
 - detecting the presence of the human and tracking an amount of time the human is present in at least one area; and
 - using the amount of time to derive a measure of risk exposure to the human.
10. An apparatus for obtaining data to determine an insurance premium, the apparatus comprising:
 - at least one sensor for determining the presence of a human in an at least one area;
 - and a processor for receiving a signal from the sensor to indicate the presence of a human, and for tracking an amount of time the human is present in the at least one area,

wherein one or more processors receive data derived from the signal to determine, at least in part, an insurance premium.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Williams	US 6,057,764	May 2, 2000
Burge	US 2002/0111725 A1	Aug. 15, 2002
Naghavi	US 2002/0184055 A1	Dec. 5, 2002
Kern	US 6,604,080 B1	Aug. 5, 2003
Omron ¹	JP 10-048008 A	Feb. 20, 1998

The following rejections are before us for review:

The Examiner rejected claims 1-5 and 10 under 35 U.S.C. § 103(a) as unpatentable over Naghavi, Williams, Omron, and Burge.

The Examiner rejected claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Naghavi, Williams, Omron, Burge, and Kern.²

The Examiner rejected claims 11-14 under 35 U.S.C. § 103(a) as unpatentable over Williams, Naghavi, Kern, and Burge.

¹ Appellants refer to this reference as “Omron,” which is the assignee. *See e.g.*, Br. 2. The Examiner refers to this reference as “JP’008.” Ans. 3. However, when discussing the disclosure of Omron, it appears to us that the Examiner is referring to the DERWENT English Abstract (DERWENT-ACC-NO: 1998-196920). *See e.g.*, Ans. 4 and 7. As such, for the purpose of this appeal, we shall refer to the DERWENT English Abstract as “Omron.”

² Although in this rejection the Examiner does not refer to Burge explicitly, because claims 6-9 depend from claim 1 we consider the omission of Burge a typographical error. *See* Ans. 7.

The Examiner rejected claims 15-18 under 35 U.S.C. § 103(a) as unpatentable over Naghavi, Williams, Omron, Burge, and Official Notice.

THE ISSUES

Has the Examiner provided an adequate reason with rational underpinning that would have led a person of ordinary skill in the art to combine the teachings of Naghavi, Williams, Omron, and Burge in the manner called for in independent claims 1 and 10?

Has the Examiner provided an adequate reason with rational underpinning that would have led a person of ordinary skill in the art to combine the teachings of Williams, Naghavi, Kern, and Burge in the manner called for in independent claims 11 and 14?

SUMMARY OF DECISION

We REVERSE.

OPINION

The obviousness rejection based on Naghavi, Williams, Omron, and Burge

The Examiner found that (1) Naghavi discloses a method for assessing risk to a human in an environment having multiple areas; (2) Williams discloses detecting the presence of a human in at least one area; (3) Omron discloses tracking the amount of time a human is present in at least one area; and (4) Burge discloses measuring a risk in real-time in order to calculate an insurance premium. Ans. 3-4. The Examiner concluded that:

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Naghavi with the

aforementioned feature from Williams with the motivation of having a means of calculating a risk assessment based upon data on the presence of individuals in certain environments, as recited in Williams (Col. 5, Ln. 63-67).

Ans. 3-4.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Naghavi in view of Williams in view of JP'008 with the aforementioned teachings from JP'008 with the motivation of providing a means wherein a use of the method could judge the presence of a person within a predetermined measurement range, as recited in JP'008 (Abstract).

Ans. 4.

At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the combined teachings in the references above with the aforementioned teachings from Burge with the motivation of being able to calculate more accurate rates, as recited in Burge (Section [0001]). (Note: In Burge the actual risk is a function of the amount of time the vehicle is on the road because this is when there is a risk of an accident.

Id.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

We find that the Examiner's explanation of the rejection consists of nothing more than a series of essentially unconnected discussions of selected teachings of references followed by a conclusory statement of obviousness. The determination as to whether there was an apparent reason to combine the known elements of Naghavi, Williams, Omron, and Burge in the manner claimed requires an analysis regarding the teachings of Naghavi, Williams, Omron, and Burge and the knowledge of a person having ordinary skill in the art. However, the Examiner has not provided an analysis as to how the known elements of Naghavi, Williams, Omron, and Burge would be combined in the manner called for in independent claims 1 and 10. For example, the Examiner has not explained how Williams' system for detecting the presence of a person in a specific area (*see* col. 5, l. 63 through col. 6, l. 22), Omron's device for tracking the amount of time a person stays within an area (*see* p. 1-2), and Burge's system for determining an insurance premium based on a consumer's vehicle operating information (*see* p. 2, para. [0049]) would be combined with the personal healthcare management system of Naghavi for assessing in an out-of-hospital setting (*i.e.*, home) the health risk of a patient using the patient's symptoms, measured physiological data, and past medical history (*see* Naghavi, p. 2, para [0024] and p. 7, para [0086]) so as to obtain the claimed subject matter of independent claims 1 and 10. Furthermore, as noted above, the Examiner has not articulated an adequate rationale as to why, absent hindsight gleaned from Appellants' disclosure, a person of ordinary skill in the art would have been prompted to combine the teachings of Naghavi, Williams, Omron, and Burge. *See In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)) ("rejections on obviousness

grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

Accordingly, the rejection of independent claims 1 and 10, and dependent claims 2-5, cannot be sustained. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

With respect to claims 6-9, the Examiner's proposed modification based on Kern does not cure the deficiencies of Naghavi, Williams, Omron, and Burge as discussed above. *See* Ans. 8. Accordingly, the rejection of claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Naghavi, Williams, Omron, Burge, and Kern likewise cannot be sustained.

Similarly, with respect to claims 15-18, the Examiner's proposed modification based on Official Notice does not cure the deficiencies of Naghavi, Williams, Omron, and Burge as discussed above. *See* Ans. 12. Accordingly, the rejection of claims 15-18 under 35 U.S.C. § 103(a) as unpatentable over Naghavi, Williams, Omron, Burge, and Official Notice likewise cannot be sustained.

The obviousness rejection based on Williams, Naghavi, Kern, and Burge

At the outset, we find that the Examiner's explanation of the rejection consists of nothing more than a series of essentially unconnected discussions of selected teachings of references followed by a conclusory statement of obviousness. *See* Ans. 9-10. As we have previously noted, the determination as to whether there was an apparent reason to combine the known elements of Williams, Naghavi, Kern, and Burge in the manner

claimed requires an analysis regarding the teachings of Williams, Naghavi, Kern, and Burge and the knowledge of a person having ordinary skill in the art. However, the Examiner has not provided an analysis as to how the known elements of Williams, Naghavi, Kern, and Burge would be combined in the manner called for in independent claims 11 and 14. Furthermore, the Examiner has not articulated an adequate rationale as to why the combined teachings of Williams, Naghavi, Kern, and Burge would have been obvious to a person of ordinary skill in the art.

Moreover, pointing to column 7, line 64 through column 8, line 15 of Kern, the Examiner takes the position that Kern discloses “calculating an insurance premium based at least in part on the amount of time the worker spends in the at least one liability zone.” Ans. 9. However, we find that in the cited portion, Kern discloses a method for assessing risk liability based on “multiplying the rate for a particular occupational classification by the respective payroll per \$100 for all of the employers’ employees.” Kern, col. 8, ll. 3-4. We could not find any portion in Kern that discloses calculating an insurance premium based on the *amount of time* an employee (worker) spends in a certain area, as contended by the Examiner. Accordingly, since the Examiner has erred in the interpretation of the disclosure of Kern, the Examiner’s conclusion of obviousness based on the teachings of Williams, Naghavi, Kern, and Burge is likewise flawed.

In conclusion, the rejection of independent claims 11 and 14, and dependent claims 12 and 13, also cannot be sustained. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

CONCLUSIONS

The Examiner has not provided an adequate reason with rational underpinning that would have led a person of ordinary skill in the art to combine the teachings of Naghavi, Williams, Omron, and Burge in the manner called for in independent claims 1 and 10.

The Examiner has not provided an adequate reason with rational underpinning that would have led a person of ordinary skill in the art to combine the teachings of Williams, Naghavi, Kern, and Burge in the manner called for in independent claims 11 and 14.

DECISION

The decision of the Examiner to reject claims 1-18 is reversed.

REVERSED

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